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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
SAVAGE, MATTHEW O	
ART UNIT	**PAPER NUMBER**
1724	

DATE MAILED: 03/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/713,835	WHITMORE ET AL.	
	Examiner	Art Unit	
	Matthew O. Savage	1724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 February 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 5-31* is/are pending in the application.

4a) Of the above claim(s) *12-25* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-11 and 26-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2-13-06*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-3, 5-11, and 26-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The concept of the filtration canister being adapted to receive a plurality of sizes of filter elements as recited in claim 1 is considered new matter.

With respect to claim 8, the concept of the evaporator cup including a substantially large flat lower surface for increasing the surface area of the fluid is considered new matter.

With respect to claims 8 and 31 the limitation of the fluid flowing underneath the heating wand to spread and increase the surface area of the fluid facilitating evaporation of the liquid contaminants is considered new matter.

With respect to claim 29, the concept of the gasket for sealing the head against the filtration canister being formed of stainless steel and a fluid impervious washer formed of nitrile material is considered new matter.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8, 9, 26, 27, 28, and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Concerning claim 8, it is unclear as to what size "a substantially large" implies.

With respect to claims 26 and 28, it is unclear as to what type of steel "Aluminum Kone Drawing Quality cold rolled steel" implies, as to what type of plating "Commercial Bright Nickel Plating" implies, and as to what type of aluminum "319 Cast Aluminum Alloy" implies.

Concerning claim 31, it is unclear as to how fluid flowing under the wand increases the surface area of the fluid when the cup is filled with fluid.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 5, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al.

With respect to claim 1, DePaul et al disclose a filtration canister 122 for filtering particulates from the fluid (see FIG. 12); and a separate evaporation canister 152 (see FIG. 16) for removing liquid contaminants by evaporation; the filtration canister further including a cylindrical container 123, a filter element 138 for removing the particulates from the fluids the filtration canister adapted for receiving one of a plurality of sizes of

the filter element and for receiving fluid via a pipe connection; a head 126 for sealing an upper portion of the container, and means for securing and sealing the head and the filter element therein without allowing fluid to bypass the filter element (e.g., the threaded connection. DePaul et al fail to specify a threaded stud for securing the head and the container, and a centering spring for securing the filter element around the threaded stud. Winslow et al disclose a filter including a threaded stud 21 for securing a head 11 to a container, and a centering spring 37 for securing a filter element 19 around the threaded stud, and suggests that such an arrangement is capable of removing sludge from the oil. It would have been obvious to have modified the apparatus of DePaul et al so as to have included the filter as suggested by Winslow et al in order to remove sludge from lubricating oil.

Concerning claim 2, DePaul et al and Winslow et al disclose filters adapted for filtering oil.

As to claim 3, DePaul et al and Winslow et al discloses filters adapted for filtering hydraulic fluid since oil is a form of hydraulic fluid and both DePaul et al and Winslow et al disclose filters capable of filtering oil.

Regarding claim 5, Winslow et al disclose the head of the canister as including a compression ring 18 for pressing against a portion of the filter element, a first orifice 12 for receiving oil from an engine, a second orifice 17 for receiving filtered oil, and a gasket for sealing the head against the filtration canister (see FIG. 1).

With respect to claim 30, Winslow discloses the head as including an outer raised edge that is oriented to be placed inside the container (see FIG. 1)

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al as applied to claim 1 above, and further in view of Kucik.

DePaul et al and Winslow et al fail to specify a valve adapted for sampling fluid during fluid flow into the filtration canister. Kucik discloses a valve 7 capable of sampling fluid during fluid flow into a filtration canister and teaches that such a valve facilitates the drainage of oil from the canister to prevent the spillage of oil when removing the canister. It would have been obvious to have modified the combination suggested by DePaul et al and Winslow et al so as to have included the valve as suggested by Kucik in place of the drain plug 34 of Winslow et al in order to facilitate drainage of oil from the canister to prevent the spillage of oil when removing the canister.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al as applied to claim 1 above, and further in view of Wheeler.

DePaul and Winslow et al fail to specify a shut-off valve for preventing flow of fluid into the filtration canister. Wheeler discloses a shut-off valve for preventing the flow of oil into a filtration canister 26 and suggests that such an arrangement enables changing of the filter element without interrupting engine operation. It would have been obvious to have modified the combination suggested by DePaul et al and Winslow et al and so as to have included the shut-off valve as suggested by Wheeler in order to enable changing of the filter element without interrupting engine operation.

Claims 8, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al as applied to claim 1 above, and further in view of Whitmore.

With respect to claim 8, DePaul et al disclose the evaporator canister as including a head 156 for sealing an upper portion of the evaporation canister, an evaporator 154 for receiving filtered fluid from the filtration canister, and a heating wand 155 for heating the fluid to release liquid contaminants. DePaul et al and Winslow et al fail to specify an evaporator cup having a substantially large flat lower surface. Whitmore discloses an evaporator cup having a substantially large flat lower surface 26 and a heating wand 29 positioned so that fluid can flow underneath the heating wand and suggests that such an arrangement increases the efficiency of the evaporator. It would have been obvious to have modified the combination suggested by DePaul et al and Winslow et al so as to have included the details of the evaporator as suggested by Whitmore in order to increase the efficiency of the evaporator.

Regarding claim 9, Whitmore et al disclose the evaporator cup as including exterior ridges 32 for impeding the flow of the fluid.

Concerning claim 11, Whitmore disclose a metering valve (e.g., the flow screw 24) located between the filtration canister and the evaporation canister (e.g., between in relation to the flow path between the filtration canister and evaporation canister) capable for selective positioning (e.g., since it is threaded) to control the fluid flow.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al as applied to claim 1 above, and further in view of Landry.

With respect to claim 10, DePaul discloses a conduit for receiving and removing vaporized liquid contaminants from the evaporation canister but fails to specify a visual indicator for alerting a user as to whether electrical power is supplied to the heating wand. Landry broadly discloses the concept of providing a visual indicator in the form of a light 27 for alerting a user as to whether electrical power is being provided to a heater 13. It would have been obvious to have modified the apparatus of DePaul so as to have included a visual indicator for alerting a user as to whether or not electrical power is supplied to the heater as suggested by Landry in order to provide an indication of proper operation of the heating wand.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al and Whitmore as applied to claim 8 above, and further in view of Connelly et al and Schneider.

DePaul et al, Winslow et al, and Whitmore fail to specify the container as being formed of nickel plated steel and the head as being formed of cast aluminum. Connelly et al disclose the combination of a steel container 5 and a cast aluminum head 4 and suggests that such a configuration reduces the weight of the filter. It would have been obvious to have modified the combination suggested by DePaul et al, Winslow et al, and Whitmore so as to have included a steel container and cast aluminum head as suggested by Connelly et al in order to reduce the weight of the filter. Connelly fails to

specify cold rolled steel or 319 aluminum alloy, however, such a modification would have been obvious in order to optimize the strength of the filter housing for a particular application. DePaul et al, Winslow et al, Whitmore, and Connelly et al fail to specify the container as being formed of nickel plated steel. Schneider discloses forming a container 34 from nickel plated steel and suggests that the plating prevents corrosion of the container. It would have been obvious to have modified the combination suggested by DePaul et al, Winslow et al, Whitmore, and Connelly so as to have included a nickel plated container as suggested by Schneider in order to prevent corrosion of the container.

Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al and Whitmore as applied to claim 8 above, and further in view of Priest.

DePaul et al, Winslow et al, and Whitmore fail to specify an orifice in the head for receiving wires that supply electrical power to the heating wand. Priest discloses that it is known to provide an orifice in the head 41 of an analogous apparatus for receiving wires that supply electrical power to a heater and suggests that such an arrangement facilitates connection of the wires to adjacent equipment. It would have been obvious to have modified the combination suggested by DePaul et al in view of Winslow et al and Whitmore so as to have included an orifice in the head for receiving wires of the heating wand as suggested by Priest in order to facilitate connection of the wires to adjacent equipment.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Winslow et al and Whitmore as applied to claim 1 above, and further in view of Connelly et al and Schneider.

DePaul et al and Winslow et al fail to specify the container as being formed of nickel plated steel and the head as being formed of cast aluminum. Connelly et al disclose the combination of a steel container 5 and a cast aluminum head 4 and suggests that such a configuration reduces the weight of the filter. It would have been obvious to have modified the combination suggested by DePaul et al and Winslow et al so as to have included a steel container and cast aluminum head as suggested by Connelly et al in order to reduce the weight of the filter. Connelly fails to specify cold rolled steel or 319 aluminum alloy, however, such a modification would have been obvious in order to optimize the strength of the filter housing for a particular application. DePaul et al, Winslow et al, and Connelly et al fail to specify the container as being formed of nickel plated steel. Schneider discloses forming a container 34 from nickel plated steel and suggests that the plating prevents corrosion of the container. It would have been obvious to have modified the combination suggested by DePaul et al, Winslow et al, and Connelly so as to have included a nickel plated container as suggested by Schneider in order to prevent corrosion of the container.

Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over DePaul et al in view of Whitmore.

With respect to claim 31, DePaul et al disclose a filtration canister 122 for filtering particles from a fluid (see FIG. 16), a separate evaporation canister 149 for removing liquid contaminants by evaporation, the evaporation canister including a container 151 for receiving the fluid and housing an evaporator 162, and a heating wand 155. DePaul et al fail to specify an evaporator cup as recited in the claim. Whitmore discloses an evaporator including a container 12 for receiving fluid and housing an evaporator including an evaporator cup 26 for receiving fluid having an interior portion 30 and an exterior portion 28 (see FIG. 2), a heating wand 29 for heating the fluid to release liquid contaminants, the interior portion of the evaporator fills with heated fluid to a point at which it spills over the exterior portion of the evaporator cup (see the second paragraph of col. 2), the fluid flowing underneath the wand (e.g., since the wand is spaced above the bottom of the cup), the purified liquid collecting at a lower portion 36 of the evaporation canister. Whitmore suggests that such an arrangement increases the efficiency of the evaporator. It would have been obvious to have modified the combination suggested by DePaul et al and Winslow et al so as to have included the details of the evaporator as suggested by Whitmore in order to increase the efficiency of the evaporator.

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's arguments filed 1-17-06 have been fully considered but they are not persuasive.

Applicant argues that there is no motivation to combine DePaul et al and Landry, however, it is held that there is sufficient motivation to combine the references since both references disclose heating devices for use with internal combustion engines.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew O. Savage whose telephone number is (571) 272-1146. The examiner can normally be reached on Monday-Friday, 7:00am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on (571) 272-1166. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M. Savage

Matthew O Savage
Primary Examiner
Art Unit 1724

mos
March 27, 2006